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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,475	07/09/2001	Dominique Briere	011496/236625	7468

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EXAMINER

DAVIS, ROBERT B

ART UNIT	PAPER NUMBER
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1722

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/902,475

Applicant(s)

BRIERE ET AL.

Examiner

Robert B. Davis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 22-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 08/945,089.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Response to Amendment***

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/15/2005 has been entered.

***Priority***

2. The foreign priority claim filed on March 10, 2005 was not entered because the foreign priority claim was not filed during the time period set forth in 37 CFR 1.55(a)(1). For original applications filed under 35 U.S.C. 111(a) (other than a design application) on or after November 29, 2000, the time period is during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. For applications that have entered national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the claim for priority must be made during the pendency of the application and within the time limit set forth in the PCT and the Regulations under the PCT. See 37 CFR 1.55(a)(1)(ii). If applicant desires priority under 35 U.S.C. 119(a)-(d), (f) or 365(a) based upon a prior foreign application, applicant must file a petition for an unintentionally delayed priority claim (37 CFR 1.55(c)). The petition must be accompanied by (1) the claim (i.e., the claim required by

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35 U.S.C. 119(a)-(d) and (f) and 37 CFR 1.55) for priority to the prior foreign application, unless previously submitted; (2) a surcharge under 37 CFR 1.17(t); and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.55(a)(1) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

### ***Reissue Applications***

3. Claims 22-44 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue, which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Original claim 1 of the patent included the following limitations.

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1. Device for manufacturing containers, made of a thermoplastic by blow molding or stretch-blow molding of a preheated preform, the said device including at least one mold (1) consisting of two half-molds (2) respectively supported by two mold carriers (3) which can move one with respect to the other, characterized in that each half-mold (2) comprises a shell holder (9) supported by the respective mold carrier (3) and a shell (7) which is provided with a half-impression (8) of the container to be obtained and which can be removably fastened to its shell holder (9) by quick-fixing means (19-23), the shell (7) and the shell holder (9) being in complementary shapes in order to be in at least partial mutual thermal-conduction contact while the pipes and connections for the circulation of cooling and/or heating fluids (11, 12) are provided exclusively in the shell holder.

The claim was amended to recite the following:

1. Device for manufacturing containers, made of a thermoplastic by blow molding or stretch-blow molding of a preheated preform, the said device including at least one mold (1) consisting of two half-molds (2) respectively supported by two mold carriers (3) which are made in the form of enveloping structures and which can move one with respect to the other, characterized in that each half-mold (2) comprises a shell holder (9) supported by the respective mold carrier (3) and a shell (7) which is provided with a half-impression (8) of the container to be obtained and which can be removably fastened to its shell holder (9) by quick-fixing means (19-23), the shell (7)

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and the shell holder (9) being in complementary shapes in order to be in at least partial mutual thermal-conduction contact while the pipes and connections for the circulation of cooling and/or heating fluids (11, 12) are provided exclusively in the shell holder.

Claim 22 recites a mold assembly comprising two mold shells and two mold shell holders and at least two axial positioning assemblies. Claim 22 does not include the mold carriers in the form of enveloping structures or the at least one quick fixing means. Claim 27 includes the mold shell, at least two coupling members and the shell holders. Claim 27 does not include the mold carriers in the form of enveloping structures or the at least one quick fixing means.

Hence, these claims are broader than the patent claim 1. Further, the subject matter of original claim 1 was amended to overcome an art rejection. Applicant added to the limitation of "two mold carriers" the following phrase "which are made in the form of enveloping structures". On page 6 of the amendment filed September 28, 1998, applicant argues "Appel does not teach or suggest a device with mold carriers which sound (typo for surround) respective shell holders. Moreover, even if one imagines that elements 43, 44 in Appel are shell holders, that elements, 130, 131 are shells and that elements (axis and arms 118-121) are mold carriers, such an argument would be erroneous from a structural point of view. This is true for at least the reason that the above-mentioned elements are obviously pivot elements corresponding to axis 4 of the present invention. Moreover, even assuming arguendo that rods 118-119 are mold carriers, said rods are surely not surrounding elements, and they cannot provide rigidity,

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contrary to standard mold-carriers." It is clear that the mold-carriers are positive structural elements of claim 1 of the patent. It is further clear that the mold carriers limitation was amended and argued by applicant to overcome a prior art rejection. The present claims 22 and 27 have been amended to further define the structure of the mold shell to have at least two axial positioning assemblies or coupling members to fix the shell in an axial direction with respect to a mold shell holder, but the absence of the mold carriers being in the shape of enveloping structures and the at least one quick fixing means constitutes recapture. See *In re Clement*, 45 USPQ2d 1161 (Fed. Cir. 1997).

Newly added claims 32-44 do not include any limitations of the shell holder and are thus further removed from the amended claim 1 of the Patent. Applicant has argued that claim 22 recites the shape of the mold carrier by the shape of the shell holder. It is not clear how claims 32 or 38 have any limitation to overcome the recapture rejection. Claims 32 and 38 not only do not recite the mold carrier, but also fail to recite the shell holder. Since the mold carrier was amended to overcome a prior art rejection it is clear that the new claims are attempting to recapture subject matter to the mold shell only.

### ***Response to Arguments***

4. Applicant's arguments filed September 15, 2005 have been fully considered but they are not persuasive. Applicant argues that the examiner indicated allowable subject matter in the Patent before subject matter was surrendered and therefore applicant is entitled to a subcombination claim having some of the features indicated as allowable. The claims submitted in this reissue application are still directed to a subcombination of

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the allowed claims and still lack the limitation surrendered in the Patent. The fact that some limitations were indicated allowable before surrendering of subject matter is not seen as pertinent to the recapture rejection at hand. The fact remains that subject matter was surrendered and applicant has only pointed to subject matter, which would have been allowed at one point.

Applicant argues the recapture rejection by stating that the shape limitation has not been removed. This is the main issue in this case. The examiner's position is such that the mold carriers and their shape have been left out of the present claims.

Applicant attempts to amend the shape of the shell holder by stating "said shell holders being shaped to be supported by two mold carriers made in the form of enveloping structures moveable one with respect to the other." The examiner cannot agree that this significantly limits the structure of the shell holders as the shell holders as shown in figure 1 can be sufficiently supported by flat platens as done in rectilinear mold closing and clamping assemblies well known in the art. The enveloping mold carrier is more a function of the book-style or clam-shell type closing and clamping assembly disclosed in the patent and not the specific shape of the shell holder. It is the examiner's position that the claims as amended in this reissue application fail the first step of the recapture rule process, as the mold carriers and their shape, and the quick-fixing means are absent from each of the independent claims. The fact that the axial positioning means is now a limitation and thus the claims are more defined for this reason is irrelevant as the independent claims are broader in regard to the surrendered subject matter-the mold carriers and their shape. It is clear from the record of the patented file that the



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mold carrier limitation was amended to overcome a prior art rejection and specifically argued in the remarks accompanying said amendment.

The arguments regarding the changing of statutory class from a process or machine claim to an article claim which are functional descriptive material stored on a Computer-Readable Medium are not convincing. Applicant has taken a fact specific example, which is believed to be due to changes in patent law in regards to software patents and tried to extrapolate this fact specific example to a combination-subcombination situation within the same category of invention, which is apparatus or a machine. Applicant has not provided any evidence that eliminating elements in a machine claim to pursue a subcombination of an allowed combination avoids the recapture rule.

Applicant further argues that there is no evidence that applicant surrendered the ability to claim the invention via a different statutory category; however, combination and subcombination are not different statutory categories. It is clear that combination claims and subcombination claims are related inventions, which can be distinct. See MPEP section 806.05. Clearly, these types of claims are related as both are used industrially to make blow molded articles.

Consideration of Eggert:

The decision in *Ex Parte Eggert*, Appeal No. 2001-0790 (Bd. Pat. App. & Inter., decided May 29, 2003)(precedential opinion of an expanded panel of the Board) is not applicable to claims 15-21 and 34-40. In *Eggert*, the limitation relied-upon in the original patent prosecution to define over the prior art was not omitted in its entirety in the

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reissue claims, but rather was broadened. The reissue claims thus remained narrowed, as compared with the surrendered claim subject matter in the area related to (germane to) what was surrendered, and recapture was avoided in *Eggert*.

In the present instance, the reissue claims were narrowed, as compared with the surrendered claim subject matter only in areas not related to (not germane to) what was surrendered. The limitation "by two mold carriers (3) which can move one with respect to the other" in the claim 1 of the patent was further limited to recite "by two mold carriers (3) which are made in the form of enveloping structures and which can move one with respect to the other". The limitation of the two mold carriers was omitted in its entirety in claims 15, 35, 36 and 39 filed with the reissue application. Applicant attempted to overcome the recapture rejection by further limiting the shell holders as follows, "said shell holders being shaped to be supported by two mold carriers made in the form of enveloping structures movable one with respect to the other". However, the applicant clearly argued that the mold carriers were not a positive limitation of the claim. See remarks (9/12/2002), page 4, 4<sup>th</sup> paragraph. This argument clearly illustrates applicant's intent to eliminate the mold carriers limitation and thus results in recapture.

In conclusion, the decision of *Eggert*, Appeal No. 2001-0790 (Bd. Pat. App. & Inter., decided May 29, 2003)(precedential opinion of an expanded panel of the Board) is not on point as to the issues at hand. As pointed out above, in *Eggert*, the relied-upon limitation was not omitted in its entirety, but rather was broadened. Thus, the Board found the claims to escape the recapture doctrine. In contrast in the present instance, the relied upon limitations are omitted in their entirety.

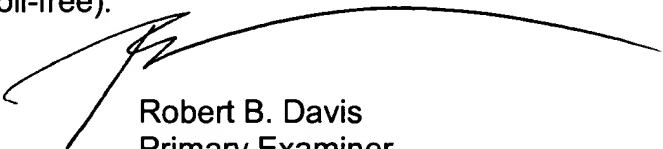
Applicants have taken the stance that the shape of the mold carrier was surrendered and not the mold carriers. This issue appears ready for consideration by the Board of Appeals as this argument if correct, makes the issue closer to Eggert than previously argued.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Davis whose telephone number is 571-272-1129. The examiner can normally be reached on Monday-Friday 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on 571-272-1166. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Robert B. Davis  
Primary Examiner  
Art Unit 1722

10/12/05